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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,933	01/07/2004	Peter M. Bonutti	2500DV2CN2DV3CN8	5806

7590 06/12/2007
Patent Counsel
United States Surgical, a division of
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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

MAIL DATE	DELIVERY MODE
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06/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/752,933

Applicant(s)

BONUTTI, PETER M.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 is confusing and inaccurate since no tissue exists between the opposed surfaces of the bone joint.

Claims 1-9, 11 and 12-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Simpson et al. (4,323,071). Simpson et al. disclose cannula 21 and a retractor including shaft 38 that has a first lumen 44 therethrough and inflatable bladder 43 disposed adjacent a distal end of the shaft 38, the inflatable bladder 43 including a opening extending therethrough (the lumen within the portion of the member 37 that extends through bladder 43, noting that this lumen extends through the bladder 43 since it extends through a portion of member 37 which, in turn, extends through bladder 43), such that a surgical instrument may traverse the first lumen 44 (A surgical instrument passing within member 37 inherently traverses first lumen 44. Dictionary.com defines "traverse" as "to pass over along or through" and "to extend across or over: A bridge traverses a stream." A surgical instrument passing within member 37 inherently passes along the first lumen 44 since the instrument is beside and parallel to the length of the first

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lumen 44.) and the opening thereby entering the working space. The bladder 43 is inherently capable of retracting opposed surfaces of a bone joint since the inflation of the bladder would inherently apply an outward pressure against the opposed surfaces to retract them. Alternatively, it would have been obvious that inflatable bladder 43 is capable of retracting opposed surfaces of a bone joint for the reasons set forth above. As to claim 4, bladder 43 is eccentrically mounted on the shaft when it is in the configuration shown in dashed lines in figure 6B. As to claim 5, any stretching of the bladder 43 will be finished when it is fully inflated. As to claims 6 and 7, note col. 9, lines 64-68 of Simpson et al. and note that 1 atmosphere equals 760 mmHg. As to claim 8, member 66 may be considered to be part of the shaft. This portion 66 of the shaft is rigid. As to claim 11, Simpson et al. disclose an interventional instrument 116.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (4,323,071) in view of Mecca (4,690,140). Simpson et al. fail to disclose a viewing scope. However, Mecca teaches that a viewing scope (figure 10) should be inserted into guide member 1 apparently in order to obtain the advantage of viewing the interior of a blood vessel being treated. It would have been obvious to include a viewing scope

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in the Simpson et al. guide wire (described in col. 9, lines 45-64) so that it too would have this advantage.

Applicant's arguments filed April 26, 2007 have been fully considered but they are not persuasive. Applicant argues on page 6 of the response that inflatable portion 43 of Simpson et al. is disposed *near* the distal end of the shaft but not *adjacent* thereto. This argument is not persuasive because the definition of "adjacent" is "close to; lying near".

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

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Thaler whose telephone number is (571) 272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

mht



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731